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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,630	11/20/2001	Francis Ford Coppola	01-374	9977

7590 04/29/2004

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EXAMINER

FIDEI, DAVID

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 04/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/989,630		COPPOLA, FRANCIS FORD	
	Examiner		Art Unit	
	David T. Fidei		3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 18 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-14 is/are allowed.
- 6) ☒ Claim(s) 1, 11 and 15 is/are rejected.
- 7) ☒ Claim(s) 2-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Election/Restrictions

1. Claims 16-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the response filed 2/13/04.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon et al (Pub US2002/0063081) in view of Nava et al (Patent no. US 6,196,411). In the embodiment of figures 8 and 8A an alternate embodiment is disclosed in Gordon et al where the disc shaped media case 14 serves as a "base" for a container 12. Page 5, paragraph [0067] states the media case 14 can be attached in the same manner as discussed in connection with the other embodiments. In paragraph [0068] the media case "base" is described as being either frictionally or threadably attached to the container. The media case 14 in these embodiments also includes a central post (not numbered) that is shown in the drawings to hold the compact disc. The difference between the claimed subject matter and Gordon et al resides in the case affixed to the base of the beverage container.

Nava et al relates to the packaging art dealing with the problem of providing associated products for a combined function. A beverage container is provided with base cover to hold a second promotional product. It would have been obvious to one of ordinary skill in the art to modify the Gordon et al by employing a beverage container as suggested by Nava et al. The motivation for this combination is to provide a promotional associated with the beverage container.

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As to claim 11, it would have been within the level of ordinary skill to provide any conventional beverage container as a matter of design choice. The motivation for the modification being that one skilled in the art would have found the particular container to be of little criticality as it would be advantageous to use any commercially viable container.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Nedblake Jr. (Patent no. 5,664,671). A beverage container 12 is disclosed with a case defined by container/housing 14 affixed to the container base. Since the case can accommodate what appears to be a hamburger, the case is taken to be capable of the function claimed. A slot is formed in the case by the removal of cover 34 of case 14 where the bottom section 32 has an upper edge forming an opening for insertion of the product.

Allowable Subject Matter

6. Claims 2-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 12-14 are allowed.

Response to Arguments

8. Applicant's arguments filed February 13, 2004 have been fully considered but they are not persuasive.

Claim 15 recites a combination including a case affixed to the base of the beverage container, having a "slot" into which at least one compact disc may be placed.

Applicant disagrees with the examiner, as simply removing cover 34 from the case will not form a slot for insertion of the product. In the package taught by Nedblake, Jr., the case has a cover 34 and a lower section 32. The upper surface of the cover mates with and engages base 20 of the beverage container. Once the case is engaged with the beverage container, it is held into place by a coupling band 16 of shrink-wrap. If cover 34 is removed from the case, then sidewalls 42 of lower section 32 must mate with base 20 of the beverage container. In order to keep sidewalls 42 mated with base 20, the coupling band 16 of shrink-wrap must be used. The shrink-wrap would hold the sidewalls 42 tight to the base 20 and would fill in any minor gaps created between the two. Therefore, there could not possibly be an aperture formed between the sidewalls of the case and the base of the beverage container in which a product may be inserted. Since the case taught by Nedblake, Jr. could not have a slot, as claimed in the present application, Nedblake, Jr. does not anticipate Claim 15.

However, it is believed applicant assigns, or reads, more into the claim than is set forth. A case is recited as "affixed to the base of the beverage container, having (to possess, contain or include)¹ a slot (an opening (a gap, hole, or empty space) into which something may be put)¹ into which at least one compact disc may be placed". Considering the full breath of the claim² it is not seen where Nedblake Jr. fails to include a case that has an empty space, opening or slot into which a compact disc may be placed. Notwithstanding the fact that a coupling band of shrink wrap holds the components of Nedblake together in the final product, the bottom part 32 of case

¹ Wordsmyth Dictionary - Thesaurus

² Claims are to be given their broadest reasonable during prosecution, see *In re Priest*, 582 F.2d 33, 37 USPQ 11, 15 (CCPA 1978), and limitations from the specification will not be read into the claims, see, e.g. *In re Prater*, 415 F.2d 1393, 1404-1405, 162 USPQ 541, 550-51 (CCPA 1969). Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997), see MPEP 2106.

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14 clearly incorporates an opening, slot or empty space into which the product 36 is placed prior to final assembly. Accordingly, the rejection is maintained as Claim 15 is anticipated in this sense of the meaning.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Patent Electronic Business Center (EBC) will be the organizational contact for Patent Business external customers regarding questions about IFW images viewed in Private PAIR. External customers should be directed to EBC representatives, who can be reached at

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703-305-3028 or toll free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at: ebc@uspto.gov. Additional information is available on the Patent EBC Web site at: <http://www.uspto.gov/ebc/index.html>.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to David T. Fidei whose telephone number is (703) 308-1220. The examiner can normally be reached on Monday, Thursday and Friday 8:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached at (703) 308-2672.

Effective Monday morning, August 4, 2003, all official faxes for the TCs will be received in one central location in the Office. In cooperation with the Customer Service Goal Team, a new central official fax number (703-872-9306) has been established for use by the TCs. An OG notice will be issued and the Website updated to alert PTO customers of the new fax number. Official standalone (non-RightFax) fax machines will be removed from the TC fax centers, their phone numbers auto-forwarded to a single RightFax account, and faxes printed in the centralized fax center.

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Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8497
Assignment Branch	(703) 308-9723
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	http://www.uspto.gov/


David T. Fidei
Primary Examiner
Art Unit 3728

dtf
April 27, 2004